REMARKS/ARGUMENTS

Claims 1-44 are pending in this application.

Claim Rejections – 35 U.S.C. § 102

The Patent Office rejected Claims 1-14, 17-20, 23-26, 29-32 and 35-44 as being anticipated under 35 U.S.C. § 102(b) by Klosterman (U.S. Patent No. 5,550,576). Applicant respectfully traverses. Applicant respectfully submits that a *prima facie* case of anticipation has not been established for Claims 1-14, 17-20, 23-26, 29-32 and 35-44.

The present invention is directed to an information handling system for utilizing an electronic program guide to control tuning sources (e.g., television, VCR, DVD or the like) disposed at remote locations from the location where a tuning device (first device) is directly connected to an information handling system. The information handling system also comprises a home network device registry applications programming interface, and a device registry of network devices which is database providing information of devices and configuration of devices coupled to a network.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that Claims 1 and 6 include elements that have not been disclosed, taught or suggested by Klosterman. For example, Klosterman fails to disclose, teach or suggest "determining which of the devices are tuning sources based on information from a device registry of the network," as recited in Claims 1 and 6.

Instead, Klosterman merely teaches a scheme for merging various television schedule information received from multiple source devices coupled to a single television. The source devices in Klosterman include an IRD box, a cable box and a television tuner which receive television schedule information from separate sources. For example, a television is coupled to a cable box receiving channel information from a local cable and an IRD box receiving different channel information from a satellite dish. The system merges cable channel information and satellite channel information and displays the merged channel information on the television. As a result, a user can watch a channel either from local cable or satellite dish via the television. However, in Klosterman, there is no step in which the system determines which of the devices are tuning sources.

Furthermore, Klosterman fails to disclose, teach or suggest "information from a device registry of the network." The device registry in the present invention is a database providing information of each device coupled to the network. A search of the entire specification of Klosterman failed to find disclosure relating to a database providing device information. Thus, Klosterman fails to teach, suggest, or disclose "determining which of the devices are tuning sources based on information from a device registry of the network," as recited in Claims 1 and 6.

Accordingly, under *Lindemann*, a *prima facie* case of anticipation has not been established. Removal of the pending rejection to Claims 1 and 6 under 35 U.S.C. §102 is respectfully requested. Claims 2-5 and 7-10 are believed to be allowable based on their dependence upon allowable base claims.

Regarding the rejection of Claims 11, 23, and 41, Applicant respectfully submits that Claims 11, 23 and 41 include elements that have not been disclosed, taught or suggested by Klosterman. For example, Klosterman fails to teach, disclose or suggest "determining whether the identified device is capable of providing programming material

based on information from a device registry of the network,"(emphasis added) as recited in Claims 11, 23 and 41.

In Klosterman, all the source devices (e.g. an IRD box, a cable box and a television tuner) disclosed are already connected to a television. Therefore, in Klosterman, there is no step in which a device is discriminated to determine if the device is capable of providing programming material. Furthermore, as indicated in the above argument, "information from a device registry of the network" as recited in Claims 11, 23 and 41 has not been disclosed, taught or suggested by Klosterman.

Thus, Klosterman fails to teach, suggest, or disclose "determining whether the identified device is capable of providing programming material based on information from a device registry of the network," as recited in Claims 11, 23 and 41.

Accordingly, under *Lindemann*, a *prima facie* case of anticipation has not been established. Removal of the pending rejection to Claims 11, 23 and 41 under 35 U.S.C. §102 is respectfully requested. Claims 12-14, 17-20, 24-26, 29-32, 35-40 and 42-44 are believed to be allowable based on their dependence upon allowable base claims.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected Claims 15-16 and 27-28 under 35 U.S.C. § 103(a) as being obvious over Klosterman in view of Tsumori ("Tsumiri", U.S. Patent No. 5,438,372). The Patent Office rejected Claims 21-22, and 33-34 under 35 U.S.C. § 103(a) as being obvious over Klosterman in view of Iwamura ("Iwamura", U.S. Patent No. 5,883,621). Applicant respectfully traverses these rejections.

When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable

expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986). Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 citing *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As indicated in the foregoing *Claim Rejections – 35 USC § 102* section, the primary reference, Klosterman fails to disclose, teach or suggest all the elements recited in Claims 11 and 23. Applicant respectfully submits that any of ancillary references, Tsumori or Iwamura, does not make up for the defects of Klosterman since Tsumori discloses a television receiver that is capable of providing the picture in picture function and Iwamura discloses a method and apparatus for providing a device control with a topology map (representing interconnections between network device) in a digital network. Furthermore, any of the references (Klosterman, Tsumori and Iwamura), either alone or combination thereof, fails to teach, suggest, or disclose all the elements recited in independent Claims 11 and 23.

Thus, independent Claims 11 and 23 are nonobvious under 35 U.S.C. § 103(a). Claims 15-16, 21-22, 27-28 and 33-34 are believed to be allowable based on their dependence upon allowable base claims. Removal of all the pending rejections under 35 U.S.C. §103 is respectfully requested.

CONCLUSION

In light of the foregoing arguments and amendments, reconsideration of all pending claims is requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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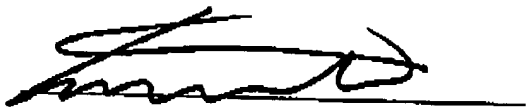
By: 

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